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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,837	05/21/2002	Motoki Kato	275749US6PCT	2212

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
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2621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/018,837	<b>Applicant(s)</b> KATO ET AL.	
	<b>Examiner</b> HUY T. NGUYEN	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/19/01</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 3-4 , 7-9 , 12-14,17-18 and 22-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 3-4,7-9,12-14,17-18 and 22-23 direct to medium and/or a program or information since the program and/or information does not provide any functional interrelationship to the medium to control the operation of the medium or to interact with any means to control reading the recorded information, or impart to any structural software and hardware components to perform certain function that is processed by a computer, the information or program do not make them statutory. See MPEO 2100.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

Art Unit: 2621

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Hamada (6,999,674).

Regarding claims 1 and 9 Hamada discloses an information processing apparatus (Figs. 1-3, 9-11, columns 2, 9-10) comprising:

generating means for generating the playback designation information (playlist) specifying the sequence of reproducing the information recorded on a recording medium and the management information supervising said playback designation information; and

recording means for recording said playback designation information and said management information, generated by said generating means, on said recording medium (Figs. 1, 3-4, 9-10);

said management information containing the name information (playlist name, Fig. 9) ) pertinent to the name assigned to said playback designation information at a time point of completion of playback which is based on said playback designation information;

said playback designation information containing the temporal information on a time point of completion of reproduction which is based on said playback designation information (playlist start time and playlist end time Figs. 10, 27-29, column 9-10) .

Method claims 2-4 correspond to apparatus claim 1. Therefore method claims 2-4 are rejected by the same reason as applied to apparatus claim 1.

Art Unit: 2621

Further for claims 2-4, Hamada teaches using a program or a program on a medium (13, Fig. 1 column 5, lines 50-65) comprise the steps recited in claims .

Reagrding claim 5, Hamada discloses an information processing apparatus (Fig. 1) for reproducing the main information from a recording medium having recorded thereon the playback designation information specifying the playback sequence of said main information recorded and the management information supervising said playback designation information (Figs. 3-4, 9-10), said apparatus comprising:

control means for controlling the playback of the main information on said recording medium based on said management information containing the name information pertinent to a name assigned to said playback designation information at a time point of completion of playback, performed in accordance with said playback designation information, and on said playback designation information containing the temporal information on time point of completion of playback performed in accordance with said playback designation information. (Figs. 27-29, columns 11-12).

Method claims 6-8 correspond to apparatus claim 1. Therefore method claims 2-4 are rejected by the same reason as applied to apparatus claim 1.

Further for claims 6-8, Hamada teaches using a program or a program on a medium (13, Fig. 1 column 5, lines 50-65) comprise the steps recited in claims .

5. Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Saeki et al (7,079,757).

Regarding claims 1,5,9 Saeki discloses an information processing apparatus (Figs. 15-18) for recording information and management information on and from a recording medium comprising:

generating means for generating the playback designation information (reproduction order ) specifying the sequence of reproducing the information recorded on a recording medium and the management information supervising said playback designation information(column 22, lines 25-45); and

recording means for recording said playback designation information and said management information, generated by said generating means, on said recording medium (Figs.24-25);

said management information containing the name information (title or cell number )) pertinent to the name assigned to said playback designation information at a time point of completion of playback which is based on said playback designation information (column 9, columns 17-18, column 21, lines 1-14);

said playback designation information containing the temporal information on a time point of completion of reproduction which is based on said playback designation information (column 10, lines 33-60).

Method claims 2-4 ,6-8 correspond to apparatus claims 1,5 and 9. Therefore method claims 2-4 and 6-8 are rejected by the same reason as applied to apparatus claims 1,5 and 9.

Further for claims 2-4 and 6-8, Saeki teaches using a program or a program on a medium that comprises the steps recited in claims 2-4 and 6-8 since Saeki teaches that the apparatus uses a computer for controlling the recording and reproducing the information and the management information .

Regarding claims 10, 14,15,19 and 21-23, Saeki discloses an information processing apparatus for recording information on a medium and for reproducing the recorded information comprising:

generating means for generating the playback designation information specifying the sequence of reproducing the information recorded on a recording medium and the management information supervising said playback designation information (Figs 24-25, column 10, lines 1-21) ;

recording means for recording said playback designation information and said management information, generated by said generating means, on said recording medium (Figs. 24-25);

said management information containing reading permission information ( reproducing order information ) pertinent to allowance of reading of the totality of the playback designation information supervised by said management information (column 10, lines 5-20)

said playback designation information containing the reading permission information pertinent to allowance of reading of said playback designation information (column 10, lines 5-20).

Art Unit: 2621

Method claims 11-13,16-18 and 20 correspond to apparatus claims 10,15 and 19. Therefore method claims 11-13.,16-18 and 20 are rejected by the same reason as applied to apparatus claims 10,15 and 19.

6. Claims 10-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsumoto (6,526,218).

Regarding claims 10, 14,15,19 and 21-23, Matsumoto discloses an information processing apparatus for recording information on a medium and for reproducing the recorded information comprising:

generating means for generating the playback designation information specifying the sequence of reproducing the information recorded on a recording medium and the management information supervising said playback designation information (column 3, lines 18-50) ;

recording means for recording said playback designation information and said management information, generated by said generating means, on said recording medium ((column 3, lines 18-50) ;

said management information containing reading permission information (restriction information ) pertinent to allowance of reading of the totality of the playback designation information supervised by said management information (column 3, lines 18-50) Figs. 14-17 column 2, lines 44-60 column 11)

said playback designation information containing the reading permission



Art Unit: 2621

information pertinent to allowance of reading of said playback designation information (Figs 2-3, column 6 lines 15-67).

Method claims 11-13,16-18 and 20 correspond to apparatus claims 10,15 and 19. Therefore method claims 11-13.,16-18 and 20 are rejected by the same reason as applied to apparatus claims 10,15 and 19.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H.N

HUY NGUYEN  
PRIMARY EXAMINER

